

Serial No. 10/665,530  
Reply to Office Action dated March 16, 2006

Docket No. MEMS-0178-US

**REMARKS/ARGUMENTS**

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 15-27 are pending in the application.

**Double Patenting**

The foregoing amendment to claim 23 clarifies the dependency, which Applicant believes resolves the double patenting issue raised.

**Specification Informalities**

The specification was objected to because of informalities. This Amendment addresses this objection by correcting the noted informalities in the specification. Accordingly, withdrawal of this objection is respectfully requested.

**Claim Objections and 35 U.S.C. § 112 Rejections**

Claim 15 was objected to because of informalities. Each of the informalities identified in the Office Action has been addressed in this Amendment. Applicant accordingly requests the Examiner to reconsider and withdraw these objections.

Claims 20-23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter set forth therein. Applicant respectfully submits that "the size of" the optical elements is not an indefinite term as it merely provides an order of magnitude as to what range in size of the element may be. Applicant accordingly requests the Examiner to reconsider and withdraw this rejection.

Serial No. 10/665,530  
Reply to Office Action dated March 16, 2006

Docket No. MEMS-0178-US

The foregoing claim amendments to address the 35 U.S.C. § 112, second paragraph rejections and claim objections were made to correct formalities such as grammatical errors and to place the present Application in better form for examination. Therefore, the foregoing amendments do not narrow the scope of the pending claims.

### **35 U.S.C. § 102 & 103 Rejections**

Claims 15-16, 18 and 20-23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Chui et al. (U.S. Patent No. 7,006,426, "Chui"). Claim 17 was rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Chui. Claim 19 was rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Chui in view of Hafner et al. (U.S. Patent No. 6,716,409, "Hafner"). Applicant respectfully traverses each of these rejections for at least the following reasons.

The Examiner has referenced Chui as teaching all the features of Applicant's claimed combinations in regard to claim 15. For example, as best understood, the Examiner has used element 12 of Chui as allegedly teaching the "reference optical element" and element 22 of Chui as allegedly teaching the "a mounting system". However, it is unclear as to what in Chui the Examiner is alleging teaches the at least a first optical element attached to a predetermined structure of said etched structures. It appears from page 4 of the Office Action that the Examiner is alleging that element 12 is also the first optical element. Applicant respectfully submits that the combination as claimed is not taught by Chui and that element 12 cannot be both the alleged reference optical element and the first optical element. If the Examiner maintains this rejection in view of Chui, Applicant respectfully requests the Examiner specifically point out the elements of Chui that teach the specific features of Applicant's claimed combinations.

Serial No. 10/665,530

Docket No. MEMS-0178-US

Reply to Office Action dated March 16, 2006

Further, regarding claim 18, for example, the Examiner apparently alleges that the "reflective thin films" taught by Chui serve as a "filling compound" as recited in Applicant's claimed combinations. Applicant respectfully submits that a reflective thin film is not a filling compound as alleged and that one skilled in the art would not consider the reflective thin films taught by Chui to be a filling compound. Further, the Hafner reference relied upon in relation to claim 19 does not teach the use of Epoxy-Master Bond EP19HT as a filling compound and is not directed to optical elements. Instead, Hafner merely teaches to use this compound "increase the adhesion between the nanotube and commercial silicon tip".

As stated in MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). None of the Chui reference applied by the Examiner neither expressly nor inherently describes every feature of Applicant's claimed combinations as detailed in the foregoing arguments. Therefore, Applicant respectfully submits that the applied reference does not anticipate Applicant's claimed combinations as alleged by the Examiner.

Further, the remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination. Additionally, new dependent claims 24 - 27 provide further features not taught or suggested by the applied references.

Serial No. 10/665,530  
Reply to Office Action dated March 16, 2006

Docket No. MEMS-0178-US

**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

**Deposit Account Authorization**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,  
McGrath, Geissler, Olds & Richardson, PLLC

  
\_\_\_\_\_  
Mark E. Olds  
Registration No. 46507

PO BOX 1364  
Fairfax, VA 22038-1364  
1.703.621.7140

**Date: September 18, 2006**